

DOCKET NO.: 266383US6PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 3637

Yves DEMARS, et al.

SERIAL NO: 10/530,060

EXAMINER: A, PHI DIEU TRAN

FILED: April 4, 2005

FOR: INSULATING GLAZING PANEL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

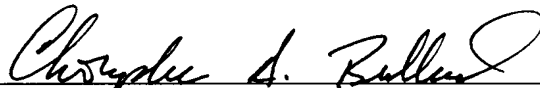
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Appellants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

I. FAILURE TO PRESENT A *PRIMA FACIE* CASE OF OBVIOUSNESS

Appellants submit that the Office Action of September 24, 2007 has failed to provide a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to independent Claim 13.¹

It is well established that “[d]uring patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability.” *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152 (Fed. Cir. 2002) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), and *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). “To support the conclusion that the claimed invention is directed to obvious subject

¹ See Office Action of September 24, 2007, detailing the rejection of Claims 13-19 and 22-24 under 35 U.S.C. § 103(a) as unpatentable over Hornung (U.S. Patent No. 6,974,518) in view of Itoh (U.S. Patent No. 5,437,902).

matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the present case, the proposed combination of Hornung and Itoh fails to disclose all of the limitations of Claim 13, and the Final Action fails to provide a convincing line of reasoning as to why an artisan would have found the absent claimed limitations to have been obvious in light of the combined teachings of Hornung and Itoh.

Independent Claim 13 recites an insulating glazing panel that includes at least two glass panes separated by a gas space and a spacer configured to keep the two glass panes apart. The spacer includes at least one approximately flat strip fitted at least partly around a perimeter of the glazing panel and fixed by adhesive bonding using at least a first fastener. The strip is fitted substantially toward an interior of the glazing panel set back with respect to at least one end face of one of the glass panes and is adhesively bonded against at least one internal face of the one glass pane. Independent Claim 13 further recites that:

wherein the strip includes an internal face that *at least partially faces the gas space*, and at least a portion of the first fastener is placed *on the internal face* of the strip

Thus, Claim 13 requires that (1) a portion of the claimed first fastener be placed on the claimed internal face of the strip, in which the claimed internal face (2) at least partially faces the claimed gas space. Neither Hornung nor Itoh, either alone or in combination, disclose or suggest this combination of features.

The outstanding Office Action acknowledges that “Hormung [sic] does not show the strip fixed by adhesive bonding using at least a first fastener, the first fastener having at least a portion placed on the internal face of the strip, and is adhesively bonded against at least one

internal face of the one glass pane, wherein at least the first fastener includes means for sealing with respect to the interior of the glazing panel.”² The outstanding Office Action attempts to cure the deficiencies in Hornung by applying Itoh, asserting that “Itoh discloses that the strip (3) fixed by adhesive bonding using at least a first fastener (5), a first fastener having at least a portion (at the corner) placed on the internal face of the strip, and is adhesively bonded against at least one internal face of the one glass pane, wherein at least the first fastener includes means for sealing with respect to the interior of the glazing panel.”³ Appellants respectfully disagree with the line of reasoning set forth in the outstanding Office Action.

Claim 13 requires a strip that includes an internal face that *at least partially faces a gas space*, and that at least a portion of the claimed first fastener is *placed on the internal face of the strip*. By contrast, as can be seen in Figures 1A-1F of Itoh, the adhesive 5 is interposed between the spacer 3 and each of the plate-shaped vitreous materials 2 and 2’. Itoh extols the benefits of placing the adhesive 5 in this location, stating that “[t]he fire-resistant glass of FIG. 1B is a modification of FIG. 1A, wherein the contact area of an adhesive 5 is made large and resultantly the adhesive 5 can respond to deflection of plate-shaped vitreous materials 2 and 2’ and can exhibit its adhesivity sufficiently.”⁴ However, contrary to the assertion in the outstanding Office Action, Itoh fails to disclose or suggest that any of the adhesive 5 is located on an internal face that at least partially faces *a gas space* between the plate-shaped vitreous materials 2 and 2’.

² See the outstanding Office Action at page 3, lines 13-16.

³ See the outstanding Office Action at page 3, lines 17-20.

⁴ See Itoh at column 8, lines 64-68.

Thus, when the outstanding Office Action argues that “Itoh discloses...a first fastener having at least a portion (at the corner) placed on the internal face of the strip,” the outstanding Office Action is relying on an argument that the placement adhesive 5 between the spacer 3 and each of the plate-shaped vitreous materials 2 and 2’ *inherently* results in the claimed configuration. However, “[t]hat which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *See In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The inherency assertion in the outstanding Official Action is incorrect and unsupported. The fact that the adhesive 5 is interposed between the spacer 3 and each of the plate-shaped vitreous materials 2 and 2’ does not demonstrate that that at least a portion of the adhesive 5 is placed *on the internal face* of the spacer 3 that *at least partially faces a gas space*. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may *not* be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added) (citation omitted) (quoting *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). Itoh explicitly describes that the adhesive 5 is interposed between the spacer 3 and each of the plate-shaped vitreous materials 2 and 2’. Nevertheless, in rejecting Claim 13, the outstanding Office Action relies on a mere possibility that some of the adhesive

5 is displaced from this location without providing any factual basis or technical reasoning to support its position. Thus the rejection based on the combination of Hornung and Itoh is improper and should be withdrawn.

Indeed, Itoh fails to disclose or suggest an internal gas space. Instead, as can be seen in Figures 1A-1F of Itoh, “an aqueous gel 4 is filled up to the ends of the plate-shaped vitreous materials 2 and 2’.”⁵ Thus, Itoh fails to disclose or suggest at least two glass panes separated by a gas space, much less that at least a portion of a first fastener is placed on an internal face of a strip that at least partially faces a gas space.

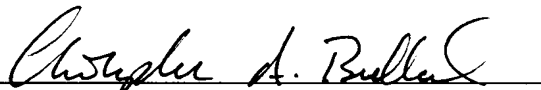
Accordingly, even the combined teachings of Hornung and Itoh fail to disclose or suggest all the features of independent Claim 13. It is submitted that independent Claim 13 and the claims depending therefrom are in condition for allowance.

II. CONCLUSION

As the Office has failed to establish a *prima facie* case of obviousness in view of the clear factual and legal deficiencies outlined above, Appellants respectfully submit that this application is now in condition for allowance.

Respectfully submitted,

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⁵ See Itoh at column 9, lines 1-5.